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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,993	09/30/2003	David A. Daugherty	3227-022	7254

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EXAMINER

NGUYEN, CAMTU TRAN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/676,993	Applicant(s) DAUGHERTY ET AL.	
	Examiner Camtu T. Nguyen	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23 and 30, drawn to a device for supporting an injured limb or body part, classified in class 602, subclass 36.
- II. Claims 24-29, drawn to a device for supporting an injured limb or body part, classified in class 128, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claims 1 and 30 do not set forth the details of the subcombination to the extent set forth in claim 24. The subcombination has separate utility such as a device for supporting an injured limb or body part that does not required retaining means.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Scott Smilie on March 8, 2005 a provisional election was made without traverse to prosecute the invention of group I, claims 1-23 and 30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 19, and 20 recite the limitation "the retaining end" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claims.

These claims are further rejected as best can be understood and interpreted below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 13, 14, 21-23, and 30 are ejected under 35 U.S.C. 102(b) as being anticipated by Bates et al (U.S. Patent No. 4,562,834). Bates et al discloses in Figures 1-4 a limb covering device (10) made up of two sheets sealed together, the device comprising tabs (22) having openings (24) therein to receive strap members (34). Figure 4 illustrates one end (38) of strap (34) is removably looped in and is retained in a D-shaped ring (39) and Bates et al discloses the strap (34) is made of neoprene closed-cell rubber material which is capable of “cling” to itself for securing the other end of the strap (34) about a limb.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10, 13-23, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. Patent No. 3,745,998) in view of Polk (U.S. Patent No. 6,913,483). Rose discloses in Figure 1 a rigidifiable and collapsible support utilized as orthopedic casts and slings comprising a closed envelope (36) formed by upper sheet (31) and lower sheet (30) and is filled

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with particles (37). The device is wrapped firmly about the patient's limb and is secured by "Velcro" hook fabric straps (39). The device further comprising tubing (42) to permit air or gas to inflate or exhaust from the device. Figure 24 illustrates another embodiment of the device comprising a plurality of carrying handles (81). Figure 24 also illustrates the plurality of carrying handles (81) are arranged in pairs about the periphery of the envelope (76). The Rose device as illustrates in Figure 24, however, does not teach a first retaining means and a second retaining means, as recited. Polk discloses in Figure 2a and 6-8 a shoelace securing apparatus (10b) in T-shaped comprising a tab portion (21) and rectangular strip portion (22) and both portions having hook material (28). Figures 6-8 illustrates the device is looped under the knot (31) in the direction of arrow and the hook material (28) on the tab portion (21) engages the hook material (24) of the rectangular strip portion (25). Therefore it would have been obvious to one skilled in the art to loop the T-shaped securing apparatus suggested by Polk in the Rose's a corresponding carrying loops (81) as such would secure the securing apparatus around the closed envelope (76).

Claims 1, 4-10, 13-23, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. Patent No. 3,745,998) in view of Torrey et al (U.S. Patent No. 6,763,554). Rose discloses in Figure 1 a rigidifiable and collapsible support utilized as orthopedic casts and slings comprising a closed envelope (36) formed by upper sheet (31) and lower sheet (30) and is filled with particles (37). The device is wrapped firmly about the patient's limb and is secured by "Velcro" hook fabric straps (39). The device further comprising tubing (42) to permit air or gas to inflate or exhaust from the device. Figure 24 illustrates another embodiment of the device comprising a plurality of carrying handles (81). Figure 24 also illustrates the plurality of

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carrying handles (81) are arranged in pairs about the periphery of the envelope (76). The Rose device as illustrates in Figure 24, however, does not teach a first retaining means and a second retaining means, as recited. Torrey et al discloses in Figures 4a and 4b T-shaped tie having a tab (14) at one end and a tail end (19) at the other end and the tie having a hook surface (18) on one surface and a loop surface (20) on the other surface. The tail end (19) is capable of inserting through a hole and retained in place by the tab (14). Therefore it would have been obvious to one skilled in the art to insert the tail end (19) of Torrey et al's tie into Rose's carrying loops (81) and retained the tie in place by the tie's tab (14) and secure the tie around the closed enveloped (76) by mating the tie's hook surface (18) with the tie's loop surface (20).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. Patent No. 3,745,998) in view of Polk (U.S. Patent No. 6,913,483) or Torrey et al (U.S. Patent No. 6,763,554) above, and further in view of Varona et al (U.S. Patent No. 6,838,154). Rose, as modified by Polk or Torrey et al above disclose a rigidifiable and collapsible support utilized as orthopedic casts and slings comprising a closed envelope (36) and elements set forth in these claims but does not teach a side of the envelope (36, 76) is an embossed material, as recited. Varona et al discloses an outer cover is typically formed of a thin thermoplastic film, such as polyethylene film, which is substantially impermeable to liquid. Varona et al further discloses the polyethylene film outer cover may be embossed (column 22 lines 4-41). Therefore it would have been obvious to one skilled in the art make the upper sheet (30) of Rose's envelope (36, 76) using Varona et al's material as such would permit air to flow to the patient's limb.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. Patent No. 3,745,998) in view of Polk (U.S. Patent No. 6,913,483) or Torrey et al (U.S. Patent No.

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6,763,554) above, and further in view of Ross et al (U.S. Patent No. 5,743,878). Rose, as modified by Polk or Torrey et al above disclose a rigidifiable and collapsible support utilized as orthopedic casts and slings comprising a closed envelope (36) and elements set forth in these claims but does not teach a filter, as recited. Ross et al discloses a filter in the tubing line (column 5 lines 15-17). Therefore it would have been obvious to one ordinary skill in the art to place a filter in Rose's tubing (42) as such would retain the particles (37) inside the envelope (76).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. Patent No. 3,745,998) in view of Polk (U.S. Patent No. 6,913,483) or Torrey et al (U.S. Patent No. 6,763,554) above, and further in view of Ross et al (U.S. Patent No. 5,743,878). Rose, as modified by Polk or Torrey et al above disclose a rigidifiable and collapsible support utilized as orthopedic casts and slings comprising a closed envelope (36) and elements set forth in these claims but does not teach a clamp, as recited. Ross discloses in Figure 5 a tube (20) through which treatment fluid is infused and an occluder (104) preferably a clamp external to the tube (20) that which operates by pinching off the tube (20) to close it and releasing from the tube (20) to open it (column 8 lines 1-10 and column 12 lines 1-4). Therefore it would have been obvious to one skilled in the art to install an occluder taught by Ross et al external of Rose's tube (42) as such would regulate air flow.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 703-305-0537. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Camtu Nguyen  
March 9, 2005



Henry Bennett  
Supervisory Patent Examiner  
Group 3700